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In re Application of
LUCAS et al.
U.S. Application No. 10/586,842
PCT No.: PCT/AU05/00061
Int. Filing Date: 20 January 2005
Priority Date: 20 January 2004
Attorney Docket No.: 03164.0203USWO
For: METHOD AND APPARATUS FOR
TESTING FIBRES

DECISION ON REQUEST

This decision is issued in response to applicants' "Communication Regarding Notification of Defective Response" filed 27 September 2007 which is being treated as a Petition to Correct Inventorship under 37 CFR 1.497(d). The \$130 petition fee has been charged to counsel's deposit account.

BACKGROUND

On 20 January 2005, applicants filed international application no. PCT/AU05/00061 which claimed a priority date of 20 January 2004. The international application named Stuart Lucas and Stuart Gordon as applicants/inventors. Pursuant to 37 CFR 1.495, the deadline for payment of the basic national fee in the United States was to expire 30 months from the priority date, 20 July 2006.

On 20 July 2006, applicants filed a transmittal letter for entry into the national stage accompanied by, *inter alia*: the requisite basic national fee; a copy of the international application; and a preliminary amendment.

On 02 April 2007, the United States Designated/Elected Office mailed a Notification of Missing Requirements (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) must be filed. The notification set a two-month time limit in which to respond.

On 24 April 2007, applicants filed "Communication Regarding Submission of Missing Requirements" which included a Combined Declaration and Power of Attorney executed by: Stuart Lucas, Stuart Gordon and Nicole Phair-Sorensen.

On 27 August 2007, the United States Designated/Elected Office mailed a Notification of Defective Response (Form PCT/DO/EO/916) indicating that the declaration filed 24 April 2007 was defective because it indicated additional inventors not listed on the published international application.

On 27 September 2007, applicants filed "Communication Regarding Notification of Defective Response" which is being treated as a Petition under 37 CFR 1.497(d).

DISCUSSION

As defined in 37 CFR 1.9(a)(3), a U.S. national stage application must first comply with the requirements of 35 U.S.C. 371(c) to constitute a "nonprovisional" application, therefore, applicants' request will be treated under 37 CFR 1.497(d). The present submission seeks to correct the inventorship so as to add inventor Nicole Phair-Sorensen to the application. Where, as here, the inventorship in the national stage declaration is not consistent with the inventorship in the international application, applicants must correct the inventorship pursuant to 37 CFR 1.497(d), which states the following:

(d) If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and this section names an inventive entity different from the inventive entity set forth in the international application, the oath or declaration must be accompanied by:

- (1) A statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part;
- (2) The processing fee set forth in § 1.17; and
- (3) If an assignment has been executed by any of the original named inventors, the written consent of the assignees (see § 3.73(b) of this chapter).
- (4) any new oath or declaration required by paragraph (f) of this subsection.

With respect to item (1), applicants have submitted a statement from the inventor being added, Nicole Phair-Sorensen, in which the inventor states that the earlier error in inventorship did not result from deceptive intent on her part. Item (1) is therefore satisfied.

With respect to item (2), applicants have submitted the required \$130 processing fee. Item (2) is therefore satisfied.

With respect to item (3), applicants have submitted a statement of consent to the change of inventorship executed on behalf of the assignee, Commonwealth Scientific and Industrial Research Organization. This consent is accompanied by a Statement under 37 CFR 3.73(b). Item (3) is therefore satisfied.


Item (4) does not apply to the present application.

Accordingly, applicants have satisfied all the requirements for correction of inventorship under 37 CFR 1.497(d).

CONCLUSION

The request under 37 CFR 1.497(d) is **GRANTED**.

The application is being returned to the United States Designated/Elected Office for further processing in accordance with this decision.



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